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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,951	09/23/2003	Roman Skuratowicz	16291-404	3314

23526 7590 01/24/2006

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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,951	Applicant(s) SKURATOWICZ, ROMAN	
	Examiner Everett White	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-14,16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-12,16 and 18 is/are allowed.
- 6) ☒ Claim(s) 5,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed October 10, 2005 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

- (A) Claims 2-4, 15, 17, 19 and 20 have been canceled;
- (B) Claims 1, 16 and 18 have been amended;
- (C) Comments regarding Office Action have been provided drawn to:
 - (I) 112 2nd paragraph rejection, rendered moot by new ground of rejection;
 - (II) 102(b) rejection, which has been withdrawn in part;
 - (III) 103(a) rejection, which has been withdrawn.

2. Claims 1, 5-14, 16, and 18 are pending in the case.

3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. Claims 5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 5, line 1 and Claim 13, line 2, the phrase "alkali extraction" lacks clear antecedent basis by being dependent from Claim 1 because Claim 1, as amended, does not set forth a process step that involve "alkali extraction".

5. Applicant's arguments with respect to Claims 5 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. Claim 14 stands rejected under 35 U.S.C. 102(b) as being anticipated by Sihtola (US Patent No. 3,935,022) for the reasons disclosed on pages 2 and 3 of the Office Action mailed July 8, 2005.

7. Applicant's arguments filed October 10, 2005 have been fully considered but they are not persuasive. The Sihtola patent discloses a process for precipitating hemicellulose (see abstract) wherein the hemicellulose is separated from the reactants thereof, which anticipate the purified hemicellulose of instant Claim 14. Claim 14 being

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in the form of a product-by-process does not negate the hemicellulose product disclosed in the Sihtola patent since the Office considers product-by-process claims to be product claims and process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981.

Allowable Subject Matter

8. Claims 1, 6-12, 16 and 18 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach or fairly suggest a process for the separation of purified hemicellulose from insoluble cellulose comprising the steps of adding alcohol to the caustic liquor to precipitate the hemicellulose so that the hemicellulose floats on top of the caustic liquor and alcohol and density separation of the floating hemicellulose precipitate from the insoluble cellulose and cellulose-hemicellulose complexes in caustic liquor simultaneously with precipitation of the hemicellulose wherein the ratio of alcohol to water in the caustic liquor is about 3:1 to 9:1.

10. Claims 5 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Summary

11. Claims 1, 6-12, 16 and 18 are allowed; Claims 5, 13 and 14 are rejected.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information


13. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.


E. White


James O. Wilson
Supervisory Primary Examiner
Technology Center 1600